

**REMARKS**

**Status of the claims:**

With the above amendments, claim 1 has been amended and claims 1-20 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 1 can be found in the written description and claims as originally filed. Reconsideration is respectfully requested in light of the following remarks.

**Rejections under 35 U.S.C. §101**

Claims 1-15 and 18-20 are rejected under 35 U.S.C. §101 for lacking utility. Applicants traverse.

Claim 1, as amended, relates to a method of producing a part comprising: specifying a requirement for the part to be produced; generating a recipe for production of said part conforming to said requirement; identifying a vendor capable of producing said part according to said recipe; identifying an optimal machine and tooling combination for producing said part according to said recipe; and using the optimal machine and tooling combination to produce the part according to said recipe.

Applicants assert that this claim has a credible, specific and substantial utility. The credible, specific and substantial utility is the production of a part. Please see <http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf> for the revised interim utility guidelines, which establishes what constitutes proper utility. Applicants believe that the claims, as written, satisfy the utility requirements in accordance with these guidelines. Withdrawal of the rejection is warranted and respectfully requested.

**Rejections under 35 U.S.C. § 102**

Claims 1-5 and 9-20 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Thackston '513 (US Patent No. 6,295,513). Applicants traverse.

The Examiner is reminded that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectfully submit that Thackston '513 cannot properly anticipate the instantly claimed invention because Thackston '513 fails to show each and every element of the claimed invention. For example, Thackston '513 fails to show the claimed element "identifying an optimal machine and tooling combination for producing said part according to said recipe". Thus, Thackston '513 cannot anticipate the instant invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

**Rejections under 35 U.S.C. § 103**

Claims 6-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thackston '513.

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thackston '513 in view of Kakazu '199 (US Patent No. 5,388,199).

Applicants traverse.

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, however, the Examiner has failed to show criteria 3) that the prior art reference (or references when combined) teach or suggest all the claim limitations.

As was pointed out above, Thackston '513 fails to disclose the element "identifying an optimal machine and tooling combination for producing said part according to said recipe". For this reason alone, Thackston '513 cannot render *prima facie* obvious the instant invention. Further, the Examiner acknowledges that Thackston '513 fails to disclose "the use of "plural" machines/tools in any combination". Accordingly, Applicants submit that the Examiner has implicitly acknowledged that Thackston '513 fails to render *prima facie* obvious the instant invention. This is because the Examiner has acknowledged that Thackston '513 fails to teach or suggest all of the claim limitations. The rejection over Thackston '513 is inapposite.

Kakazu '199 fails to make up for the deficiencies of Thackston '513. Applicants assert that one of ordinary skill in the art would not use the optimal machine of Kakazu '199 in combination with the NICECAD system of Thackston '513. The two systems are incompatible. Column 5, line 61 to column 6, line 9 of Thackston '513, recites:

*The virtual computer aided design (CAD) capability allows quasi- real-time discussions, including audio, video and graphics. The graphics capability allows a prime contractor and prospective fabricator to view the three-dimensional part design, including the execution of various manipulations, such as virtual rotations and translations, pan, zoom and "fly throughs." The stored part design model data may include links to associated specifications, standards and other design specific documents so that the bidding fabricator has a full representation of what it is bidding on. As with the NICECAD and GMR aspects of the integrated system, the ETC provides "data neutrality" so that format boundaries do not become impediments for either the soliciting prime contractor/designer or the bidding fabricator.*

From this passage it should be apparent that the method of Thackston '513 does not include "identifying an optimal machine and tooling combination" as recited in claim 1. This passage, in fact, shows that Thackston '513 teaches away from "identifying an optimal machine and tooling combination". It is the fabricators who look at audio, visual, and graphics through their virtual CAD capability. The fabricators (who possess the machines and tooling apparatus) determine if they can manufacture the part in accordance with the associated specifications, standards and other design specific documents on the network. Thus, there is no identifying the optimal machine and tooling combination. The fabricators simply identify if they can make the part in accordance with the specifications of the part needed. Providing a step of "identifying an optimal machine and tooling combination" would in effect destroy the purpose of the system of Thackston '513, which is to allow bidding by the fabricators.

Rather than identifying the optimal machine and tooling combination, Thackston '513 indicates that there is a minimal requirement that needs to be met (not optimal requirements). Column 3, lines 3-6 of Thackston '513 recites:

*Of the few potential candidates that may be identified through "word of mouth" or a costly search, it can be costly to evaluate whether such candidates meet minimum requirements.*

This passage indicates that there is a minimal requirement for machining and tooling the part that must be met by the fabricators. Combining these two cited passages show that Thackston '513 is interested in allowing a plurality of fabricators to bid on a process that has minimal requirements (and not an "optimal machine and tooling combination" as claimed in the instant invention). In other words, incorporating "identifying the optimal machine and tooling combination" into the process of Thackston '513 would destroy its purpose, thus, negating any motivation to modify the Thackston '513 reference. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

**Rejections under 35 U.S.C. §112, second paragraph**

Claims 1, 2, 6, 7, 9, 11, 12, 18, and 19 are rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite.

The Examiner asserts that claim 1 is indefinite because the element "identifying an optimal machining and tooling combination for production of said part" bears no support in the claim language. Applicants have amended claim 1 so there is an inter-relationship amongst the various elements in the claims. Applicants believe that with these amendments that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner asserts that claim 2 is indefinite for reciting "creating a vendor" saying that a vendor is not an entity that can be made or produced. Applicants disagree. As an example, Applicants assert that a vendor capable of producing a part may not exist, but perhaps vendors may exist that produce parts that are similar. Thus, Applicants assert that if one of the vendors can be convinced to produce the part of interest, a vendor for

that part has been created. Applicants believe that with this explanation that claim 2 can no longer be considered vague or indefinite. Withdrawal of the rejection is warranted and respectfully requested.

### CONCLUSION

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants believe that no fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

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